

R E M A R K S

The Office Action of May 24, 2001, presents the examination of claims 20-39. No new matter is inserted into the application.

Interview

Applicants' representative extends gratitude to the Examiner and Supervisory Examiner for the interview held on February 15, 2002.

Rejections under 35 U.S.C. § 103

Dower '603 in view of Hong '765

The Examiner rejects claims 20-25, 27-29, and 38-39 under 35 U.S.C. § 103(a) for allegedly being obvious over Dower '603 (USP 5,639,603) in view of Hong '765 (USP 6,165,765). Applicants respectfully traverse. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

During the interview, Applicants' representative submitted that Hong '765 is not a valid reference against the present invention. Specifically, the filing date of Hong '765 is September 21, 1998, whereas the PCT filing date of the present

invention is August 10, 1998. Thus, Hong '765 cannot be used as prior art against the present invention. Further, the Examiner cannot rely on Hong's prior applications, i.e. Application No. 08/544,643 (USP 5,747,298), which has a filing date of October 18, 1995, and Application No. 08/642,684 (USP 5,834,253), which has a filing date of May 3, 1996, since the DNA sequencing utilized in Hong '298 and Hong '253 is the Sanger-type sequencing, wherein the nucleotide analogs utilized are the terminating ddNTPs. It is known in the art that only one ddNTP can be placed into one tube and as such, the "two or more kinds of nucleotide analogs" element of the instant claims is not met. The Examiner agreed with Applicants' representative. Specifically, the Examiner wrote in the Interview Summary, "Applicants pointed out that Hong reference is not a prior art as this reference does not get priority of its CIP application. Therefore, 103(a) rejection is obviated."

Further, Applicants' representative pointed out that Dower '603 and Hong '765 also do not make the present invention obvious because neither reference discloses or suggests the use of a nucleotide analog for the purpose of amplifying DNA of a target sequence derived from RNA. Again, the Examiner agreed as evidenced in the Interview Summary, which states, "Moreover,

Dower et al. reference does not teach preparation of cDNA using nucleotide analog."

For the above reasons, the rejection under 35 U.S.C. § 103 is improper and should be formally withdrawn on the record.

Dower '603 in view of Hong '765 and further in view of Dodge '117

The Examiner rejects claims 20-30 and 38-39 for allegedly being unpatentable over Dower '603 in view of Hong '765, and further in view of Dodge '117 (USP 5,912,117). Applicants respectfully traverse. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

Again, the combination of Dower '603 and Hong '765 does not make the present invention obvious, as explained above. Further, Dodge '117 cannot be relied upon to make up for the deficiencies of these references since Dodge '117 merely teaches the use of DMSO to lower T_m value.

For the above reasons, the rejection under 35 U.S.C. § 103 is improper and should be formally withdrawn on the record.

Dower '603 in view of Hong '765, further in view of Dodge '117, and further in view of the Stratagene Catalog

The Examiner rejects claims 20-30 and 38-39 for allegedly being unpatentable over Dower '603 in view of Hong '765, further

in view of Dodge '117, and further in view of the Stratagene Catalogue (1998). Applicants respectfully traverse. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

Again, the combination of Dower '603, Hong '765, and Dodge '117 does not make the present invention obvious, as explained above. Further, the Stratagene Catalogue cannot be relied upon to make up for the deficiencies of these references since the Stratagene Catalogue merely teaches a kit.

For the above reasons, the rejection under 35 U.S.C. § 103 is improper and should be withdrawn formally on the record.

CONCLUSION

In sum, all of the present claims define patentable subject matter such that this application should be placed into condition for allowance. Early and favorable action on the merits of the present application is thereby requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kristi L. Rupert, Ph.D. (Reg. No. 45,702) at the telephone number of the undersigned below, to

conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to the provisions of 37 C.F.R. § 1.17 and 1.136(a), Applicants hereby petition for an extension of two (2) months to March 3, 2002 for the period in which to file a response to the outstanding Office Action. The required fee of \$400.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By



Marc S. Weiner
Reg. No. 32,181

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000


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